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Peter J. Dronzek JR.

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HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1791

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,116	Applicant(s) DRONZEK, PETER J.	
	Examiner John L. Goff	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-36 and 38-50 is/are pending in the application.
- 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-36 and 38-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on 6/9/09.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claims 25-36, 38-47, and 49 are objected to because of the following informalities:
Claim 25, line 2 requires “by means of based adhesive”. The claim previously required - - by means of a water based adhesive - -. It appears “water” was inadvertently removed from the claim. Claim 47, line 9 requires “or gripper” which should be deleted from the claim consistent with the amendment filed on 6/9/09. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. Claims 25, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (Specification pages 4-6) in view of Malhotra (U.S. Patent 5,885,678) or Ito et al. (U.S. Patent 5,422,175).

The admitted prior art discloses a conventional method of labeling a glass or plastic container by means of a water based adhesive through a method comprising selecting a paper based label that will readily feed from a label magazine and will allow a water based adhesive to migrate into the label, placing the label in the label magazine to form a stack of labels, feeding the label from the label magazine by contacting a back side of the label in the stack of labels with

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a pallet which applies the water based adhesive to the label to form a fastenable label, fastening the label to the container, and allowing the label to dry/cure on the container (Specification page 5, line 6 to page 6, line 10). The admitted prior art is silent as to the label comprising a microvoided polymer. It was known in the labeling art that label materials include any of paper, microvoided polymer such as microvoided polypropylene, etc. as shown by Malhotra (Column 6, lines 30-64). Ito specifically discloses a microvoided polymeric label material as a substitute for paper comprising an inner microvoided polymeric base including surface microvoids and an outer layer easily written on, the label having a high definition for printing, high durability, appearance of high quality, dimensional stability to moisture absorption, etc. (Column 1, lines 6-10 and Column 2, lines 18-28 and 37-42 and Column 3, lines 18-20 and Column 12, lines 7-10 and 23-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label material in the admitted prior art any of those known as suitable in the art for the same such as microvoided polymer an alternative to paper as shown by Malhotra only the expected results being achieved. Further or alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label material in the method taught by the admitted prior art the microvoided polymeric label taught by Ito as a substitute for paper having a high definition for printing, high durability, appearance of high quality, dimensional stability to moisture absorption, etc. The microvoided polymeric labels taught by Malhotra or Ito are considered to allow a water based adhesive to migrate into the label the same as applicants.

Regarding the limitation that the label is a "patch label", it is considered well taken in the art of labeling that there are two types of labels which include wrap labels which provided a 360

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degree wrap around the container and cut patch labels with less than 360 degree wrap as shown for example by the admitted prior art (Page 4, lines 21-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label taught by the admitted prior art as modified either of those well known to one of ordinary skill in the art such as a wrap label or a patch label as evidenced by the admitted prior art depending on the amount of information conveyed by the label, the decorative effect of the label, etc.

Regarding claim 47, Malhotra teaches the microvoided polymer is polypropylene, and Ito teaches the microvoided polymeric base includes polyolefin-type resins wherein polypropylene is specifically noted in the background of Ito (Column 1, lines 62-66 and Column 3, lines 65-66). It would have been obvious to one of ordinary skill in the art the time the invention was made to use as the polyolefin component of the microvoided polymeric base taught by the admitted prior art as modified by Ito any of the particular polyolefins suggested such as polypropylene by Malhotra and the background of Ito as only the expected results would be achieved.

Regarding claims 49 and 50, Ito specifically suggests the label has a density, i.e. specific gravity, less than 0.9 (See Example 1).

5. Claims 25, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of the admitted prior art.

Ito discloses a microvoided polymeric label material as a substitute for paper comprising an inner microvoided polymeric base including surface microvoids and an outer layer easily written on, the label having a high definition for printing, high durability, appearance of high quality, dimensional stability to moisture absorption, etc. Ito is silent as to any specific method and adhesive for using the material as a label. The admitted prior art discloses a conventional

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method of labeling a glass or plastic container by means of a water based adhesive using a paper label as more fully described above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the label material taught by Ito (a substitute for paper) to label glass or plastic containers using a water based adhesive as taught by the admitted prior art evidencing a known technique for applying paper labels to form glass or plastic containers having labels with a high definition for printing, high durability, appearance of high quality, dimensional stability to moisture absorption, etc. The microvoided polymeric labels taught Ito are considered to allow a water based adhesive to migrate into the label the same as applicants.

Regarding the limitation that the label is a "patch label", it is considered well taken in the art of labeling that there are two types of labels which include wrap labels which provided a 360 degree wrap around the container and cut patch labels with less than 360 degree wrap as shown for example by the admitted prior art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label taught by Ito as modified by the admitted prior art either of those well known to one of ordinary skill in the art such as a wrap label or a patch label as evidenced by the admitted prior art depending on the amount of information conveyed by the label, the decorative effect of the label, etc.

Regarding claim 47, Ito teaches the microvoided polymeric base includes polyolefin-type resins wherein polypropylene is specifically noted in the background of Ito (Column 1, lines 62-66 and Column 3, lines 65-66). It would have been obvious to one of ordinary skill in the art the time the invention was made to use as the polyolefin component of the microvoided polymeric

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base taught by Ito any of the particular polyolefins suggested such as polypropylene by the background of Ito as only the expected results would be achieved.

Regarding claims 49 and 50, Ito specifically suggests the label has a density, i.e. specific gravity, less than 0.9 (See Example 1).

6. Claims 25-27, 30-36, 38, 45-47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Gobel (U.S. Patent 3,296,723) in view of Malhotra or Ito and the admitted prior art.

Gobel discloses a method of labeling a glass, plastic, or metal container or surface with a printable label through a method comprising selecting a paper or polymeric patch label, applying an adhesive hydrophilic coating to the label, and drying the coating to form a label having a hydrophilic coating. Gobel further teaches using the label by applying a water based adhesive to the hydrophilic coating to form a fastenable polymeric label, and fastening the label to the container or surface (Figure 3 and Column 2, lines 9-16 and 53-65 and Column 3, lines 1-6 and Column 4, lines 33-36). Gobel is silent as to the label material comprising a microvoided polymeric material, it being noted Gobel is not limited to any particular label material and suggest as exemplary polyvinylchloride in addition to other conventional materials such as paper. It was known in the labeling art that label materials include any of paper, polyvinylchloride, and microvoided polymer such as microvoided polypropylene as shown by Malhotra (Column 6, lines 30-64). Ito specifically discloses a microvoided polymeric label material as a substitute for paper comprising an inner microvoided polymeric base including surface microvoids and an outer layer easily written on, the label having a high definition for printing, high durability, appearance of high quality, dimensional stability to moisture

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absorption, etc. (Column 1, lines 6-10 and Column 2, lines 18-28 and 37-42 and Column 3, lines 18-20 and Column 12, lines 7-10 and 23-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label material in Gobel any of those materials known as suitable in the art for the same purpose such as microvoided polymer as shown by Malhotra. Further or alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label material in the method taught by Gobel the microvoided polymeric label taught by Ito having a high definition for printing, high durability, appearance of high quality, dimensional stability to moisture absorption, etc. The microvoided polymeric labels taught by Malhotra or Ito are considered to allow a water based adhesive to migrate into the label the same as applicants.

Regarding the limitation that the label “will readily feed from a label magazine”, “placing said microvoided polymeric patch label in a label magazine and feeding said microvoided polymeric patch label from said magazine to a point where a water based adhesive is applied to said microvoided polymeric patch label by gluing a back side of said label be contacting said label with a pallet which is pressed against the first label in a stack of labels to form a fastenable polymeric patch label”, and “allowing said polymeric label to dry on said glass, plastic or metal surface or container”, Gobel does not specifically teach any specific technique for applying the water based adhesive to the label having a hydrophilic coating, it being noted Gobel is not limited to any particular technique. The admitted prior art as more fully described above discloses a conventional method of labeling a glass or plastic container by means of a water based adhesive applied to the first label of a label stack in a label magazine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the water

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based adhesive to the hydrophilic coated label and apply the label to the container as taught by Gobel using the conventional method as shown by the admitted prior art only the expected results being achieved.

Regarding the limitation that the label is a “patch label”, Gobel appears to describe a patch label (Column 4, lines 33-36), and as such is considered to meet the limitation. In the event it is shown Gobel does not necessarily teach a patch label the following rejection would apply, it being noted Gobel is not limited to any particular type of label. It is considered well taken in the art of labeling that there are two types of labels which include wrap labels which provided a 360 degree wrap around the container and cut patch labels with less than 360 degree wrap as shown for example by the admitted prior art (Page 4, lines 21-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the label taught by Gobel either of those well known to one of ordinary skill in the art such as a wrap label or a patch label as evidenced by the admitted prior art depending on the amount of information conveyed by the label, the decorative effect of the label, etc.

Regarding claim 32, the hydrophilic coating applied to the label as taught by Gobel is considered applied with 100% coverage (See the Figures).

Regarding claim 33, Gobel does not specifically teach the thickness of the water based adhesive. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine the thickness of the water based adhesive required in Gobel to achieve a good bond between the label and the container or surface as doing so would have required nothing more than ordinary skill and routine experimentation.

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Regarding claim 34, Ito teaches the polymeric label is a co-extruded film including polyester and coloring agent (Column 5, lines 13-17 and Column 9, lines 17-20).

Regarding claim 35, Ito teaches the layer easily written on that is laminated to the base considered a low density polymeric label surface may included printed indicia, e.g. a bar code, wherein it is considered obvious to one of ordinary skill in the art at the time the invention was made to use as the printed indicia on the layer easily written on taught by Gobel any decorative indicia including reverse printed indicia as only the expected results would be achieved.

Regarding claims 36 and 38, Ito teaches the polymeric label includes an outer layer easily written on that is roughened which is considered an adhesion promoting layer to promote indicia adhesion (Column 12, lines 7-10). Further, Ito teaches optionally including an inner layer of the same type which is considered a tie layer to the hydrophilic layer (Column 3, lines 15-18). It being further noted tie layers and primer are considered well known in the art for adhesion promoting such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include on either surface of the label base taught by Gobel as modified by Malhotra or Ito a well known adhesion promoting tie layer or primer.

Regarding claims 45 and 46, Gobel teaches the hydrophilic layer is a derivative of polyacrylic acid wherein absent any unexpected results it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any of the well known derivatives of polyacrylic acid such as carboxylated sodium polyacrylate.

Regarding claim 47, Malhotra teaches the microvoided polymer is polypropylene, and Ito teaches the microvoided polymeric base includes polyolefin-type resins wherein polypropylene is specifically noted in the background of Ito (Column 1, lines 62-66 and Column 3, lines 65-66).

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It would have been obvious to one of ordinary skill in the art the time the invention was made to use as the polyolefin component of the microvoided polymeric base taught by Gobel as modified by Ito and optionally the admitted prior art any of the particular polyolefins suggested such as polypropylene by Malhotra and the background of Ito as only the expected results would be achieved.

Regarding claims 49 and 50, Ito specifically suggests the label has a density, i.e. specific gravity, less than 0.9 (See Example 1).

7. Claims 28, 29, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobel, Malhotra or Ito, and the admitted prior art as applied to claims 25-27, 30-36, 38, 45-47, 49, and 50 above, and further in view of Jannusch (U.S. Patent 4,440,884).

Regarding claims 28, 29, and 44, Gobel, Malhotra or Ito, and the admitted prior art as applied above teach all of the limitations in claims 28, 29, and 44 except for a specific teaching of the water based adhesive, which is considered coated/added to the hydrophilic layer, as including a catalyst, it being noted Gobel is not limited to any particular water based adhesive and suggest a water based gum adhesive. Jannusch discloses a water based adhesive which maintains a strong bond between a label and an object to which it is attached wherein the adhesive comprises gum, starch, casein, etc. and includes a crosslinking catalyst to provide a quick bond (Column 1, lines 5-10 and Column 3, lines 36-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the water based adhesive in Gobel as modified by Malhotra or Ito, and the admitted prior art the water based adhesive including gum, starch, or casein shown by Jannusch to strongly bond the label to the container.

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Regarding claim 43, Gobel, Malhotra or Ito, and the admitted prior art as applied above teach all of the limitations in claim 43 except for a specific teaching of the hydrophilic layer including humectants. It is considered well taken in the art that a hydrophilic polymeric composition include humectants to control its viscosity, i.e. curl control and layflat properties, wherein Jannusch are exemplary of a hydrophilic composition including humectants to control the viscosity and bond strength of the composition (Column 3, lines 63-68 and Column 4, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the hydrophilic layer taught by Gobel as modified by Malhotra or Ito and the admitted prior art humectants as shown by Jannusch to control the viscosity and bond strength of the composition.

8. Claims 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobel, Malhotra or Ito, and the admitted prior art as applied to claims 25-27, 30-36, 38, 45-47, 49, and 50 above, and further in view of Kelly (U.S. Patent 4,978,436).

Gobel, Malhotra or Ito, and the admitted prior art as applied above teach all of the limitations in claims 39-42 except for a specific teaching of a protective coating placed over the printed indicia on the outer layer, e.g. a bar code label. Kelly discloses a method wherein a protective coating layer including slip aids is placed on a substrate that is used as a label wherein the coating layer has slip properties that facilitates use of the coating layer on a high speed packaging apparatus (Column 1, lines 16-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include over the outer layer of the label taught by Gobel as modified by Malhotra or Ito and the admitted prior art the protective coating shown by Kelly to provide optimum high speed application of the label.

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9. Claims 26, 27, 30-36, 38, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito and the admitted prior art as applied to claims 25, 47, 49, and 50 above, and further in view of Gobel.

Ito and the admitted prior art as applied above teach all of the limitations in claims except for a teaching of including a hydrophilic layer. Gobel discloses a method of labeling a glass, plastic, or metal container or surface with a printable label through a method comprising selecting a paper or polymeric patch label and applying a hydrophilic coating to the label. Gobel teaches the label is attached to the container or surface by applying a water based adhesive to the hydrophilic coating to form a fastenable polymeric label and fastening the label to the container or surface. Gobel teaches the hydrophilic coating prevents any tendency to curl, any tendency to exhibit stains, or any tendency of uneven or otherwise impaired adhesion due to partial repulsion of the water based adhesive by the paper or polymeric label (Column 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in Ito as modified by the admitted prior art a hydrophilic coating between the microvoided polymeric patch label and water based adhesive as shown by Gobel to prevent any tendency to curl, any tendency to exhibit stains, or any tendency of uneven or otherwise impaired adhesion due to partial repulsion of the water based adhesive by the paper or polymeric label.

Regarding claim 32, the hydrophilic coating applied to the label as taught by Gobel is considered applied with 100% coverage (See the Figures).

Regarding claim 33, the admitted prior art does not specifically teach the thickness of the water based adhesive. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine the

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thickness of the water based adhesive required in Ito as modified by the admitted prior art and Gobel to achieve a good bond between the label and the container or surface as doing so would have required nothing more than ordinary skill and routine experimentation.

Regarding claim 34, Ito teaches the polymeric label is a co-extruded film including polyester and coloring agent (Column 5, lines 13-17 and Column 9, lines 17-20).

Regarding claim 35, Ito teaches the layer easily written on that is laminated to the base considered a low density polymeric label surface may included printed indicia, e.g. a bar code, wherein it is considered obvious to one of ordinary skill in the art at the time the invention was made to use as the printed indicia on the layer easily written on taught by Ito any decorative indicia including reverse printed indicia as only the expected results would be achieved.

Regarding claims 36 and 38, Ito teaches the polymeric label includes an outer layer easily written on that is roughened which is considered an adhesion promoting layer to promote indicia adhesion (Column 12, lines 7-10). Further, Ito teaches optionally including an inner layer of the same type which is considered a tie layer to the hydrophilic layer (Column 3, lines 15-18). It being further noted tie layers and primer are considered well known in the art for adhesion promoting such that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include on either surface of the label base taught by Ito a well known adhesion promoting tie layer or primer.

Regarding claims 45 and 46, Gobel teaches the hydrophilic layer is a derivative of polyacrylic acid wherein absent any unexpected results it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any of the well known derivatives of polyacrylic acid such as carboxylated sodium polyacrylate.

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10. Claims 28, 29, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito, the admitted prior art and Gobel as applied to claims 26, 27, 30-36, 38, 45 and 46 above, and further in view of Jannusch.

Regarding claims 28, 29, and 44, Ito, the admitted prior art and Gobel as applied above teach all of the limitations in claims 28, 29, and 44 except for a specific teaching of the water based adhesive, which is considered coated/added to the hydrophilic layer, as including a catalyst, it being noted the admitted prior art is not limited to any particular water based adhesive and suggest a water based gum adhesive. Jannusch discloses a water based adhesive which maintains a strong bond between a label and an object to which it is attached wherein the adhesive comprises gum, starch, casein, etc. and includes a crosslinking catalyst to provide a quick bond. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the water based adhesive in Ito as modified by the admitted prior art and Gobel the water based adhesive including gum, starch, or casein shown by Jannusch to strongly bond the label to the container.

Regarding claim 43, Ito, the admitted prior art and Gobel as applied above teach all of the limitations in claim 43 except for a specific teaching of the hydrophilic layer including humectants. It is considered well taken in the art that a hydrophilic polymeric composition include humectants to control its viscosity, i.e. curl control and layflat properties, wherein Jannusch are exemplary of a hydrophilic composition including humectants to control the viscosity and bond strength of the composition (Column 3, lines 63-68 and Column 4, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the hydrophilic layer taught by Ito as modified by the admitted prior art and

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Gobel humectants as shown by Jannusch to control the viscosity and bond strength of the composition.

11. Claims 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito, the admitted prior art and Gobel as applied to claims 26, 27, 30-36, 38, 45 and 46 above, and further in view of Kelly.

Ito, the admitted prior art and Gobel as applied above teach all of the limitations in claims 39-42 except for a specific teaching of a protective coating placed over the printed indicia on the outer layer, e.g. a bar code label. Kelly discloses a method wherein a protective coating layer including slip aids is placed on a substrate that is used as a label wherein the coating layer has slip properties that facilitates use of the coating layer on a high speed packaging apparatus (Column 1, lines 16-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include over the outer layer of the label taught by Ito as modified by the admitted prior art and Gobel the protective coating shown by Kelly to provide optimum high speed application of the label.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 25-36, 38-47, 49, and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,663,746 in view of Malhotra or Ito and optionally the admitted prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-21 of U.S. Patent No. 6,663,746 fully encompass claims 25-36, 38-47, 49, and 50 of the instant application except for a specific teaching of using a microvoided polymer as the polymer label which is obvious in view of Malhotra or Ito for the reasons fully set forth in the rejections above.

Regarding the limitations that the label “will readily feed from a label magazine”, “placing said microvoided polymeric patch label in a label magazine and feeding said microvoided polymeric patch label from said magazine to a point where a water based adhesive is applied to said microvoided polymeric patch label by gluing a back side of said label be contacting said label with a pallet which is pressed against the first label in a stack of labels to form a fastenable polymeric patch label”, and “allowing said polymeric label to dry on said glass, plastic or metal surface or container”, claims 1-21 of U.S. Patent No. 6,663,746 teach using water based labeling equipment considered to meet the limitations. In the event it is shown using the equipment does not necessarily meet the limitations the following rejection would apply. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the water based adhesive to the label and apply the label to the container as taught by claims 1-21 of U.S.

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Patent No. 6,663,746 using the conventional method as shown by the admitted prior art only the expected results being achieved.

14. Claims 25-36, 38-47, 49, and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,306,242 in view of Malhotra or Ito and the admitted prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-45 of U.S. Patent No. 6,306,242 fully encompass claims 25-36, 38-47, 49, and 50 of the instant application except for a specific teaching of using a microvoided polymer as the polymer label which is obvious in view of Malhotra or Ito for the reasons fully set forth in the rejections above. Regarding the limitations that the label “will readily feed from a label magazine”, “placing said microvoided polymeric patch label in a label magazine and feeding said microvoided polymeric patch label from said magazine to a point where a water based adhesive is applied to said microvoided polymeric patch label by gluing a back side of said label be contacting said label with a pallet which is pressed against the first label in a stack of labels to form a fastenable polymeric patch label”, and “allowing said polymeric label to dry on said glass, plastic or metal surface or container”, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the water based adhesive to the label and apply the label to the container as taught by claims 1-45 of U.S. Patent No. 6,306,242 using the conventional method as shown by the admitted prior art only the expected results being achieved.

Response to Arguments

15. Applicant's arguments with respect to claims 25-36, 38-47, 49, and 50 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue, "Beginning at page 5, line 30 of the present specification, the applicant described the operation of a cut and stack labeling machine without reference to what stock material was used to make the label. These statements were made after stating explicitly that polymeric film would not work with this technique."

The statement referred to by applicants states the technique will not work with non-porous polymeric label substrates whereby it is inferred that the operation of a cut labeling machine is thus suitable with porous label substrates, it being noted it may be that cut labeling machines are known for use with any label substrates as no particular material is required in applicants description and it is only within the discussion of paper labels is it specifically noted paper labels are used with the cut labeling technique. In any event, microvoided polymeric patch labels are porous such that they are suitable for use with technique and machines.

Applicants argue, "At page 6, line 11, the applicant described unsuccessful attempts to apply polymeric labels with a water based adhesive using microperforated stock because those attempts resulted in applied labels that would swim or move from their intended location. This discussion of unsuccessful attempt in the prior art to use a water based adhesive on a perforated polymeric label stock does not place in the prior art a method of applying a polymeric label using a water based adhesive."

It is unclear what is meant by this statement. It is unclear if applicants are stating the unsuccessful attempts are or are not prior art. An unsuccessful attempt in the prior art to use a

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water based adhesive on a perforated polymeric label stock does place in the prior art a method of applying a polymeric label using a water based adhesive such a method simply being unsuccessful due to the labels swimming or moving. Further, a reading beginning a page 6, line 11 appears to specifically describe using perforated polymeric stock labels in the prior art with water based adhesives, i.e. attempts have been made. In any event, as it appears applicants are arguing that the description at page 6, line 11 is not prior art, i.e. it is not admitted prior art, the rejection is made over that disclosed on page 4, line 18 to page 6, line 10 which does appear to be admitted prior art.

Applicants argue, “Malhotra only uses a pressure sensitive adhesive on a polymeric label and not a water based adhesive as required by all of the claims of the present application.”.

Malhotra is applied as evidence in the labeling art that known label materials included any of paper or microvoided polymer, i.e. both materials are known as useful for the same with a reasonable expectation of success for using either material. This teaching is applicable regardless of the particular adhesive used as Malhotra does not contain any suggestion that the materials are alternatives to one another as a function of the particular adhesive used.

Applicants further argue, “The Ito patent only discloses a voided material. There is no mention in Ito of what type of adhesive could or should, be used if the product is used to make labels. Thus Ito is not a teaching reference with regard to the application of a polymeric label to a glass, plastic or metal container using a water based adhesive.”.

Ito teaches a material that is a paper substitute for a label without requiring any particular adhesive or any particular substrates to be labeled wherein the admitted prior art discloses a method of successfully adhering paper labels such that one of ordinary skill in the art requiring a

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method for adhering the paper substitute labels taught by Ito would look to the admitted prior art of known paper label adhering techniques for a technique for successfully adhering the labels of Ito.

Applicants further argue, “Example 3 of Goebel was repeated and the results were presented in a Declaration of Leslie Fernandez that is of record in U.S. 6,663,746 and a copy has been filed in the present application. That Declaration provides data that shows that the label of Example 3 will not dry and the treated surface remains sticky like cellophane tape so that those individual labels will stick to one another and cannot be used in a labeling machine where they are stacked one upon another.”.

It is noted the claims are now commensurate in scope with this argument as the claims require “a stack of labels”. However, Gobel does not teach that the hydrophilic layer has any adhesive properties, and Gobel further requires an adhesive to adhere the label with the hydrophilic layer thereon to a substrate, i.e. there is no suggestion in Goble that the label substrates with hydrophilic layer thereon could not stacked. The declaration referred to by applicants appears to suggest that if the label substrates with hydrophilic layer thereon were stacked the substrates would stick to one another and not be useful in a labeling machine. However, there are differences between the declaration and Example 3 of Gobel as has been previously noted. Most importantly, example 3 of Gobel is performed using 37.5 kg of polyvinylmethylether (70% in toluene) while the declaration used 62.5 g (40% in toluene). These differences do not appear trivial, and it is not clear that the layer taught by Gobel would perform the same as that shown in the declaration given the above differences, i.e. it may be the

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use of the larger quantity of polyvinylmethylether that results in the sticking of the hydrophilic layer. Thus, the showing is insufficient, and the rejections are maintained.

Regarding applicants arguments to Jannusch, Jannusch is cited simply to show a water based adhesive which maintains a strong bond between a label and an object to which it is attached wherein the adhesive comprises gum, starch, casein, etc. and includes a crosslinking catalyst to provide a quick bond which teaching is evident irrespective of the particular label material.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571)272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/
Primary Examiner, Art Unit 1791